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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,881	04/16/2004	Thomas S. Scanlan	TRUC-0016/2003-214-2	8599

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EXAMINER

DAVIS, BRIAN J

ART UNIT PAPER NUMBER

1621

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,881	Applicant(s) SCANLAN ET AL.	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
4a) Of the above claim(s) 23-45 and 48-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 46 and 47 is/are rejected.
- 7) ☒ Claim(s) 14 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/9/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restriction

Applicant's election, with traverse, of Group I and the species defined on page 21 of the Response (3/3/06) as the group and species elected to begin prosecution, respectively, is acknowledged.

Applicant argues that the restriction should be limited to two groups (instead of five), since the claims have been classified into only three different classes and the claims of Groups I, II, III and V are "closely related." The examiner respectfully disagrees.

First, the assigned classes are enormously broad categories and encompass a range of, for instance, structurally diverse and patentable distinct compounds. For instance, class 564, a compound class, contains 55,717 patents and pre-grant publications as of 5/16/06. Even upon further subdivision of that broad class into the various subclasses (each containing up to approximately 1000 patents), which would encompass all of applicant's Markush set of compounds, would represent a serious search burden upon the Office.

Second, an antibody and a compound of formula I are not "closely related" as applicant avers. This is, of course, why the arts into which they are classified are also unrelated (class 564 vs. class 530). The argument is spurious.

The election/restriction was made in order to facilitate the reasonably complete and thorough search to which applicant is entitled by statute and is hereby made FINAL.

Information Disclosure Statement

References 34-42 of the IDS have been lined-through. These entries relate to entire textbooks, covering a variety of topics, with no corresponding statement of relevance, or indeed, any specific reference to any immediately pertinent material.

Claim Objections

Claims 14 and 18 are objected to because of the following informalities: in the definition of R_8 , the moiety CH_2N+R_3 should properly be $CH_2N^+R_3$. Appropriate correction is required. Applicant's assistance is respectfully requested in correcting any other minor spelling/grammatical errors which may be present in the claims.

Allowable Subject Matter

The elected species has been searched and is deemed free of the prior art. The search was therefore expanded as called for under current Office Markush practice, a compound-by-compound search, to include a single additional species. That species is defined when: $R_1=R_2=R_3=R_4=R_5=R_6=R_7=H$; $Y=Z=CH_2$; $R=H$ and $n=1$. A rejection follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22, 46 and 47, in so far as they read on the species defined above, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *J. Pharmacol.* (1936), 58, p. 53-61 (CAPLUS abstract). The reference teaches applicant's compound: RN=108714-30-3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Brian J. Davis
May 16, 2006

BRIAN DAVIS
PRIMARY EXAMINER